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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
YU, GINA C

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 11/05/2002 9

Please find below and/or attached an Office communication concerning this application or proceeding.

Offic Action Summary	Application N .	Applicant(s)	
	09/897,229	REUST, HANSPETER	
	Examiner	Art Unit	
	Gina C. Yu	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

P riod for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *September 26, 2002 & October 24, 2002* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-12,14,17 and 18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5, 7-12, 14, 17, & 18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Receipt is acknowledged of Amendment and Supplement amendment filed on September 26, 2002, and October 24, 2002, respectively. Claims 1-5, 7-12, 14, 17 and 18 are pending. The finality of the previous Office action dated June 20, 2002 is withdrawn in view of applicants' remarks. The claim rejections under 35 U.S.C. § 103(a) over Phillips et al. (US 5,580,491) in view of Costa et al. (US 6,126,953) and Boothe et al. (US 4,764,365); and over the combined references and further in view of Japanese Patent 58192811 are modified to address the newly amended claim.

Claim Objections

Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation in claim 5 now does not further limit the liquid carriers recited in the amended claim 1.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

1. Claims 1-5, 7, 8, 10-12, 14, 17, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. (U.S. Pat. No. 5,580,491) ("Phillips") in view of Costa et al. (U.S. Pat. No. 6,126,953) ("Costa") and Boothe et al. (U.S. Pat. No. 4,764,365) ("Boothe").

Phillips teaches in Example 5 a method of preparing whey-containing shaving cream composition which comprises admixing a microfiltered whey protein *solution* containing 5% of solids, ethanol and oil, and heating the mixture to 74 °C for 10 minutes at 2500 psi, and then cooling to 25 °C. See instant claims 1 and 3. Examiner views that the microfiltered whey protein isolation *aqueous solution* is a mixture of whey powder in a liquid carrier. While applicants assert that the amended claim exclude alcohol or oil in the mixture, the argument is not commensurate with the scope of the claim. The prior art still meets instant claims since the liquid carrier in there is in the form of aqueous solution comprising water.

The Phillip reference further teaches that the mixture is stored for 30 days before formulating into a shaving cream. See instant claim 14. Examiner also views that although the reference does not mention whether the water used there is distilled or deionized water, given the teaching of using water in the whey solution for the use of food or cosmetic use in the reference, a skilled worker would have obviously used either type of purified water in order to eliminate the possibility of contamination. See instant claim 10. The reference lacks the teaching of heating the mixture between about 50 °C and its boiling point for 20-60 minutes as instant claims 7 and 8 require, however, examiner views that, given the teaching of heating the mixture at 74°C for 10 minutes, a skilled worker would have known to vary the heating temperature and time. The reference also lacks the teaching of liquid whey as in instant claim 19, however, examiner views that employing liquid whey to mix with whey powder would have been obvious to a skilled worker because of the expectation to produce a product with higher

concentration of whey proteins. The reference teaches that cosmetic additives, including antimicrobial actives, may be added to the composition in conventional way, while it is silent as to the specific types of the additives. See col. 2, line 62 - col. 3, line 7.

Costa teaches various personal care compositions including body lotions, shaving creams, and shampoos. See col. 2, line 15 – col. 3, line 54. The reference teaches the preservatives, including methyl, ethyl, propyl, and butyl parabens, EDTA, and imidazolidinyl urea, may be added to the water phase of the compositions in the amount of 0.2 – 2.5 %. See col. 25, lines 8 – 12. Although the reference does not teach the specific amount of the each preservative, examiner takes the position that a skilled worker would have discovered the optimum range of each amount by routine experiments. The reference lacks the teaching of citric acid.

Boothe teaches various personal care compositions including shaving creams and bath composition. See abstract. Example 1 in the reference teaches a method of preparing liquid soap which comprises adding citric acid after mixing the ingredients, heating and cooling the mixture, to adjust the pH of the solution. See col. 4, lines 17 – 61. The reference teaches to add a cationic polymer during the cooling stage, after the first stage when the mixture reaches to 50 °C, and then further cool the mixture to 45 °C before adding the citric acid. Although the reference lacks the teaching of the method steps of instant claims 11 and 12, examiner views that a skilled worker in the art would have known to add the additives in the solution either before or after the heating stage in order to avoid flashing off due to the high temperature.

Given the general teaching of adding cosmetic additives in the process of making cosmetic compositions containing whey in Phillips, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have to looked prior art such as Costa for specific types of the additives. The skilled worker would have been further motivated to employ citric acid to adjust the pH of the composition, as taught by Boothe.

2. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips, Costa, and Boothe as applied to claims 1-5, 7, 8, 10-12, 14, 17, 18 and 19 above, and further in view of Japanese Patent 58192811 ("811").

The combined references, discussed above, lack the specific method steps of instant claims 9.

'811 abstract teaches method of preparing cosmetic composition from whey, which comprises heating whey at 30-50 °C under vacuum to remove the odorous constituents. See abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of the combined references by reducing the pressure during the heating process, as taught by '811, because of the expectation of successfully removing odorous constituents from whey.

Response to Arguments

Applicant's arguments filed on September 26, 2002 have been fully considered but they are not persuasive.

Examiner maintains the position that the use of an aqueous whey solution as taught by the Philips patent renders the mixing whey powder in the recited liquid carrier obvious.

Applicants' distinction of the types of whey protein used in the prior art and the instant invention is not commensurate with the scope of the claim, as there is no such claim limitation. Also, applicants' assertion that the prior art fails to teach the heating step is also erroneous, as the prior art does teach heating the whey solution. See Phillips, Example 5. While applicants assert that the claimed method prevents the Maillard reaction, the argument is not convincing since the prior art also indicates heating whey solution under a general condition which renders the instant claim obvious.

While applicants assert that the rejection is based on random picking and choosing additives to combine the references, examiner respectfully disagrees. In this case, the recited references are relevant prior arts to instant invention, all directed to formulating personal care or cosmetic compositions. Examiner reiterates that the Phillip patent clearly suggests combining the whey protein solution with conventional additives such as antimicrobial agents to formulate a shaving cream composition. See Office action dated June 20, 2002, p. 3, 1st par, last sentence. The Costa reference provides that the recited antimicrobial agents are conventionally used in personal care compositions such as shaving cream. Examiner maintains the position that nothing nonobvious or unexpected is seen in combining old ingredients well known in the art.

Applicants also assert that the Japanese reference No. 58192811 is not relevant to the instant invention, allegedly because the present invention does not involve mammal milk. The argument is not commensurate with the scope of the claims, since there is no limitation as to the source of the whey protein used in the invention. While applicants argue that the present process of heating the protein mixture under reduced pressure is to avoid the Maillard reaction, examiner notes that the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In this case, examiner takes the position that an old process well known in the art, i.e., heating the whey protein in aqueous solution under reduced pressure, does not become patentable because applicants have different reason to employ such process.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951. The examiner can normally be reached on Monday through Friday, from 8:30 AM until 6:00 PM..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

Gina C. Yu
Patent Examiner
November 1, 2002

SREENI PADMANABHAN
PRIMARY EXAMINER

11/1/02